

Application No.: 10/042,473

### **REMARKS**

The Office Action of February 28, 2005, has been carefully considered. Reconsideration of this application, as amended, is respectfully requested. Claim 1 has been amended to remove the recitation of "non-pressurized" and to correct an informality noted therein.

Turning now, to the office action, the Request for Continued Examination filed February 9, 2005 was acknowledged and the current non-final action sets forth the following rejections: (a) claims 1 – 8, 10 – 24 and 26 – 32 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement; (b) claims 1 – 7, 10 – 24 and 26 – 32 were rejected under 35 U.S.C. §103(a) over Burris (5,213,773) in view of Burris (5,207,993); and (c) claim 8 was rejected over Burris '773 in view of Burris '993 and further in view of Burris (5,422,043) or Burris (5,858,283).

Considering, first, the rejection under 35 U.S.C. §112, first paragraph, claims 1 – 8, 10 – 24 and 26 – 32 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The rejection sets forth the recently added recitation of a "non-pressurized liquid reservoir" in place of the previously recited "liquid source." In particular, Applicants urge that the prior amendment was submitted to clarify the recited element and to distinguish from a "pressurized source" as illustrated in Fig. 3 and as described at ¶[0019]. The rejected limitation was added for clarity because the Office Action of Sept. 9, 2004 incorrectly referenced Burris 5,213,773 (see Off. Action 9/9/04, §-8, ¶3) with regard to a removable reservoir. The reservoir of the '773 patent is a treated liquid reservoir not a supply liquid reservoir and is not described as removable, as is set forth in amended claim 1 and as further discussed below.

Although Applicant has removed the term "non-pressurized" from claim 1, and urges that such a limitation is supported by the specification (see ¶[0024]), Applicant respectfully urges that one skilled in the art would know that a reservoir (see also ¶[0023]) has no capacity to hold pressure. As used in the instant application the term reservoir clearly includes an open-air storage area or a receptacle or part of a machine designed to hold fluid – common definitions. In view of the amendment to claim 1, and the discussion set forth above, Applicants respectfully traverse the rejection and earnestly submit that claims 1 – 8, 10 – 24 and 26 – 32, are presently in condition for allowance. Applicants further request that the rejection under 35 U.S.C.

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§112, first paragraph, be acknowledged as withdrawn in a subsequent communication.

Turning next to the substantive rejections under 35 U.S.C. §103(a), the disclosures of the cited art and the distinctions between the amended claims may be briefly summarized as follows:

Claims 1 – 7, 10 – 24 and 26 – 32 were rejected under 35 U.S.C. §103(a) over Burris '773 in view of Burris '993. Burris '773 is cited as teaching a liquid treatment system comprising an untreated liquid source. The referenced system of Burris '773, Fig. 4 requires supply pressure (col. 2 line 66 in conjunction with col. 5, lines 4-10 and col. 5, lines 65-66) to output treated liquid; the inlet liquid displaces liquid within the treatment system in order to cause an output of treated liquid (col. 5, lines 67-68 in conjunction with col. 5, lines 29-35). The use of a removable reservoir (i.e., unpressurized) would result in the '773 device over-filling without ever outputting the intended treated liquid. In the various embodiments of Burris '773, the apparatus is attached to an external pressurized liquid source (col. 1, lines 37-38), there are no provisions for a supply side reservoir. The reservoirs 13 referred to in the various embodiments of '773 are treated-liquid reservoirs (col. 3, lines 2-3 & col. 5, lines 14-15). The system of the present invention must output liquid containing dissolved ozone in order to fulfill the requirements of the claimed invention (amended claim 1). Claim 1 has been amended to recite a removable reservoir, and as such a structure is not taught or suggested by the '773 patent, the claimed invention is patentably distinguishable over '773 for this reason – as acknowledged by the Examiner.

Burris '993 is cited, in combination with '773, as teaching a non-pressurized reservoir. While '993 is suggested as teaching a liquid reservoir, the Examiner has not indicated a teaching for the reservoir of the '993 patent being removable. More importantly, the Examiner has not indicated what motivation (teaching or suggestion) has been relied upon to modify the '773 invention to utilize a non-pressurized reservoir – particularly when the '773 patent clearly calls for a pressurized supply (see col. 2 line 66 in conjunction with col. 5, lines 4-10 and col. 5, lines 65-66). Applicants respectfully contend, therefore, that the '773 patent teaches away from the proposed combination and use of a non-pressurized "removable reservoir" for the liquid source as recited in amended claim 1.

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In the event the Examiner maintains the rejection, Applicants respectfully request that the Examiner particularly set forth the teachings relied upon in '773 or '993, to support the statement that "it would have been obvious... to have employed a non-pressurized reservoir ... and would have given the same results. Absent such a teaching or suggestion, it seems the current application is being employed as a "recipe" by which unrelated components from Applicant's prior patents are being improperly combined to reject the claims. Such a combination does not establish *prima facie* obviousness to which Applicants can respond. In light of the traversal set forth above, Applicants respectfully submit that amended claim 1, and all claims dependent therefrom, are patentably distinguishable over the arguable combination of Burris '773 in view of Burris '993.

Claim 8 was similarly rejected over Burris '773 in view of Burris '993 and further in view of Burris '043 or Burris '283. Applicants incorporate herein, the previously presented arguments in traversal of the rejection of claim 1. Claim 8, directed to a "device ... where the ozone containing gas is pumped by a gas pump through a diffuser into the liquid." The Examiner has indicated that a diffuser is not taught by either '773 or '993. The Examiner then cites two patents in which the Applicant(s) have taught an ozone diffuser. However, the Examiner has set forth no basis within the references themselves, that would suggest such a modification of the '773 or '993 patents to add the recited element. Here again, it appears that the present application has been employed as the "recipe" by which different components from several patents have been selected to create the claimed invention. Absent reference to the specific teaching relied upon, this rejection fails to establish *prima facie* obviousness to which Applicant can or should respond. Accordingly, Applicants again respectfully request that the rejection be withdrawn and the subject matter of claim 8 be indicated as allowable in a subsequent communication.

It further appears that the Examiner recognizes the inherent deficiency of the 35 U.S.C. §103(a) rejections and seeks to bolster them (see Response to Arguments section), by urging that prior use of a component is somehow equivalent to the requisite "teaching, suggestion or motivation" to combine (see Examiner's citations to *In re Fine* and *In re Jones*). Applicant's respectfully decline to accept the Examiner's "illustration" of the use of diffuser as rising to the level of a teaching, and request, as noted above, that the basis for the combination be set forth, or that the rejection of claim 8 under 35 U.S.C. §103(a) be withdrawn.

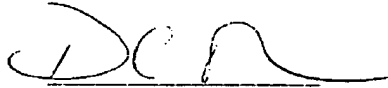
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Insofar as claims 2 – 7, 10 – 24 and 26 - 32, inclusive, are concerned, these claims all depend from now presumably allowable amended claim 1 and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to claim 1.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



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